

PCT/PTO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



IN RE APPLICATION OF:

TOMAS NILSSON

FOR:

TIRE DEVICE

SERIAL NO.

10/009,072

FILING DATE:

12/06/01

ATTORNEY DOCKET NO.

1987-A-PCT-US

RECEIVED

20 SEP 2002

U.S. Patent and
Trademark Office
International Division

PETITION TO REVIVE
OFFICE ERROR OR, IN THE ALTERNATIVE, UNINTENTIONAL ABANDONMENT

Assistant Commissioner for Patents
 Washington, DC 20231
BOX 313(b)

Sir:

In response to the Notification of Abandonment dated April 3, 2002,
 Applicant hereby Petitions to Revive the above-identified application.

This application was abandoned for failure to provide the full U.S. Basic National Fee by 30 months under 37 C.F.R 1.495(b). The Applicant contends that the failure to pay the full fee by the deadline of December 10, 2001, is based on an error by the Patent Office, or by the Patent Office failing to act in a timely fashion, or in the alternative, unintentional abandonment of the application by the Applicant.

The facts in this case are as follows:

The priority application for this case was filed on June 10, 1999, in Sweden as

~~07/23/2002 MKAYPAGH 00000028-10009072~~

~~01 EG-122~~

~~02 FG-198~~

~~130.00 UP~~

~~20.00 UP~~

application number 9902170-1. On June 7, 2000, a PCT application was filed claiming priority off the case. The PCT application number is PCT/SE00/01173. The deadline for entering the national phase in the United States was December 10, 2001.

On December 6, 2001, Applicant's U.S. attorney filed the U.S. national phase application under 35 C.F.R. 371, four days prior to the deadline for paying the full U.S. Basic National fee under 37 C.F.R 1.495(b) (2). The application was unofficially accorded serial number 10/009,072 and a filing date of 12/06/01.

The Applicant's attorney inadvertently presumed that the International Search Report was prepared by the EPO. The Applicant therefore submitted a Basic National Fee of \$890 together with a fee of \$40 for recording an assignment. The fees, totaling \$930, were submitted to the US Patent Office by way of check number 7991. In addition to submitting a check in the amount of \$930, the Applicant's attorney also authorized the Office to withdraw any additional fees required from their deposit account number 19-0083. A copy of the fee sheet authorizing the same is enclosed for review. The authorization was signed by one of Applicant's attorneys, Daniel J. Long, Reg. No. 29,404. The authorization/fee sheet was dated December 5, 2001 - five days before the full basic national fee was required. Daniel Long left the firm of Sand & Sebolt, Applicant's attorneys, in mid-January 2002. A few weeks after he left, Applicant's attorneys revoked Dan Long's authorization to withdraw monies from their deposit account.

On March 18, 2002, Applicant submitted an Information Disclosure Statement on this matter.

On April 8, 2002, Applicant received a Notification of Abandonment mailed by

the PTO on April 3, 2002. The Notification stated that the application had been abandoned for failure to pay the full fees by the deadline of December 10, 2001. Applicant's attorneys believed they had submitted the correct fees and consequently on April 9, 2002, they contacted the Patent Office to determine exactly why the application had been abandoned. The clerks with whom Applicant managed to discuss this matter could not determine why the check submitted with the application had not been applied. Applicant's attorneys therefore faxed a Response to the Notification of Abandonment to the Office in an attempt to get the facts on record at the Office. A copy of this response is attached hereto. The clerks at the Patent Office stated that the file needed to be pulled from storage and that they would bring this matter to a supervisor's attention. Applicant's attorneys called the Patent Office again on April 17, 2001 and were advised to contact Charita Burt, the person whose name appeared on the Notification of Abandonment. Mrs. Burt was called on April 17th and again on April 18th and voice mail messages detailing the problem were left for her. In early May Applicant's attorneys called the Patent Office again to try and determine why the Patent Office was contending that insufficient fees had been submitted. Applicant's attorney was advised by a PTO representative that the fee had been applied to the application five times and had been removed four times. The representative therefore concluded that the fees in the matter had in fact been paid and that the application would be reinstated. We requested confirmation of this fact. The representative advised us once again that we had to talk to Charita Burt directly and said they would leave her a message to contact us. On May 29th she called, but the attorney handling this matter was not available. Mrs. Burt was called again on May 30th and again on June 2nd. Both times voice mail

messages were left for her detailing the problem at hand. Finally, on June 5th Mrs. Burt contacted us and advised us that the problem with the application was that Applicant's attorneys had paid the Basic National Fee based on a search by the EPO instead of Sweden. There was consequently a shortfall in the fees of \$150. Mrs. Burt advised that the reason the application had been abandoned was because when the PTO came to withdraw the additionally required amount from the Applicant's attorney's deposit account, it was discovered that Daniel J. Long no longer had authorization to withdraw money from the account. Mrs. Burt advised that the attempted withdrawal from the deposit account was made in February 2002. This attempted withdrawal from the account was made two months after the deadline of December 10, 2002. Applicant's attorneys queried why the Office had not notified them of the shortfall and Mrs. Burt responded that the deadline for paying the fee had already passed and so there was no recourse at this point.

Applicant respectfully submits that the Patent Office has erred in abandoning the application by not attempting to withdraw the shortfall in funds prior to the deadline of December 10, 2001. On the date that the Patent Office received the application for filing under 35 U.S.C. 371, namely December 6, 2001, there were still four days within which to provide the additional funds. Attorney Daniel J. Long, reg. no. 29,404, was authorized to withdraw funds from Applicant's attorney's Deposit Account 19-0083 up until the end of January 2002. If the Office had attempted to withdraw funds in the period between December 6, 2001 to December 10, 2001, no problem would have been encountered with withdrawing those monies from the deposit account in question. The fact that the Office took two months, until February 2002, to access this deposit

account to withdraw the funds should not be held against the Applicant and should not cost the Applicant the opportunity to obtain patent protection for his invention in the United States.

Applicant respectfully submits that the Office erred in not attempting to withdraw the shortfall in funds prior to the deadline of December 10, 2002, even though the Office was aware of the fact that failure to provide the full Basic National Fee would result in automatic abandonment of this application.

Applicant therefore respectfully petitions that this application be revived on the grounds of Office error.

In the alternative, Applicant respectfully submits that this application was unintentionally abandoned by the Applicant. Applicant intended to pay the full Basic National Fee, but through an inadvertent error, paid a lesser amount than was required. Additionally, through unfortunate circumstances, the attorney who authorized the withdrawal of any additional funds from Deposit Account 19-0083, had left our firm by the time that the Patent Office attempted to withdraw the shortfall in fees. The Applicant therefore, in the alternative, respectfully requests revival of the application on the grounds of unintentional abandonment by the Applicant under 37 C.F.R. 1.137(b).

Applicant attaches a check for the shortfall in the required additional Basic National Fees, namely \$150.00. The Office is authorized to withdrawn any additional fees required from Deposit Account No. 19-0083.

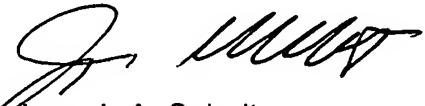
Inasmuch as the Applicant contends that this abandonment occurred through an error of the Patent Office, Applicant respectfully submits that no Petition fee is required in this instance. Should it be decided, however, that no Office error occurred and that

the application was unintentionally abandoned, the Office is hereby authorized to withdraw any funds to cover such Petition fee and any other required fees from Deposit Account No. 19-0083.

If the Office needs to discuss this matter further with the Applicant or if a telephone interview would be beneficial to revive the instant application, the Office is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted at Canton, Ohio, this 10th day of July, 2002.

SAND & SEBOLT



By: Joseph A. Sebolt
Registration No. 35,352

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JAS/ff
Attorney Docket: 1987-A-PCT-US

Enclosure: Check for \$150.00

Copy of Fee Sheet authorizing withdrawal from Deposit Account
Copy of Response to Notification of Abandonment



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States
Postal Service as first class mail in an envelope addressed to
Assistant Commissioner for Patents
Washington, DC 20231
BOX:

on this 10th day of July, 2002.


Fiona Ferguson